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| APPLICATION NO.                  | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|----------------------------------|-------------|----------------------|---------------------|------------------|
| 10/531,838                       | 04/18/2005  | Thomas Aue           | SCH-15950           | 4317             |
| 40854                            | 7590        | 12/27/2007           | EXAMINER            |                  |
| RANKIN, HILL, PORTER & CLARK LLP |             |                      | NIA, ALIREZA        |                  |
| 38210 Glenn Avenue               |             |                      |                     |                  |
| WILLOUGHBY, OH 44094-7808        |             |                      | ART UNIT            | PAPER NUMBER     |
|                                  |             |                      | 3739                |                  |
|                                  |             |                      | MAIL DATE           | DELIVERY MODE    |
|                                  |             |                      | 12/27/2007          | PAPER            |

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

|                              |                        |                     |  |
|------------------------------|------------------------|---------------------|--|
| <b>Office Action Summary</b> | <b>Application No.</b> | <b>Applicant(s)</b> |  |
|                              | 10/531,838             | AUE ET AL.          |  |
|                              | <b>Examiner</b>        | <b>Art Unit</b>     |  |
|                              | AliReza Nia            | 3739                |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 05 November 2007.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-4, 7 and 10 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-4, 7 and 10 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 5<sup>th</sup> November 2007 is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____.                                     |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____.   | 6) <input type="checkbox"/> Other: _____.                         |

## DETAILED ACTION

### *Claim Rejections - 35 USC § 103*

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. **Claims 1-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Widran 3,900,022 in view of Hayashi 5,014,708.**

3. With respect to claim 1, Widran discloses a urological resectoscope 20 including a tubular shaft 24 through which an optical system 28 and a longitudinally moveable via 48,50 instrument carrier 46 pass, a support device 60,62 supporting the optical system 28 via 34 with respect to the tubular shaft 24, and a radial positioning device 48,52, and a circumferential angular positioning device 26, positioning the instrument carrier 46, wherein the support device 60,62 is so arranged adjacent to the optical system 28 in the region in which the carrier 46 extends, that it supports the optical system 28 via 26,34 with respect to the tubular shaft 24 with a two point support system 60,62 and imparts lateral guidance to the carrier 46 in the circumferential angular direction (figs. 1,2).

4. However, Widran does not disclose the support device to be spaced from the proximal end of the tubular shaft.

5. Hayashi teaches supporting arms projecting in the diametral direction and spaced 108 from a proximal end of a tubular shaft (fig. 13) of an endoscopic therapeutic means (col. 11, lines

12-13) used for treating cancer cells, the arms supporting a cylindrical pipe within the tubular shaft (figs. 13,14a,14b, col. 11, lines 12-64).

6. It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified the resectoscope of Widran with the spacing of the arms from the proximal end of a tubular shaft taught by Hayashi in order to increase the robustness and stability of the internal elements of Widran's resectoscope allowing for quick and therapeutic treatment of cancerous tissues during endoscopic procedures.

7. With respect to claim 2, Widran in view Hayashi disclose the invention as discussed above. With respect to the recitation "the support device is so constructed that it brings the optical system into engagement with the side of the tubular shaft situated opposite to the support device in a three point support system", it would have been obvious to one of ordinary skill in the art at the time of the invention to have increased or decreased the length of one or more of the webs of the support device or changed the angle of the webs such that that the optical system would have brought the optical system into engagement with the side of the tubular shaft via 34, since it has been held that, "[W]here the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation."

In re Aller, 220 F.2d 454, 456, 105 USPQ 233, 235 (CCPA 1955) (MPEP 2144.05 II A) and since it has been held that rearranging parts of an invention involves only routine skill in the art, In re Japikse, 181 F.2d 1019, 86 USPQ 70 (CCPA 1950) (MPEP 2144.04 VI C). Moreover, it has been held that a change in the size of a prior art device is a design consideration within the skill of the art. In re Rose, 220 F.2d 459, 105 USPQ 237 (CCPA 1955).

8. With respect to claims 3 and 4, Widran in view Hayashi disclose the invention as discussed above. Widran further teaches the support device 60,62 has two circumferentially spaced, fixed webs 60,62, which are each arranged in contact with the optical system 28 via 26,34 and the tubular shaft 24 on both sides of the carrier 46 and in sliding contact with it (fig. 2) and wherein the webs 60,62 are connected to the tubular shaft 24 (fig. 2).

9. **Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Widran 3,900,022 in view of Hayashi 5,014,708 further in view of Karasawa 4,726,370.**

10. Widran in view of Hayashi disclose the invention as discussed above. However, Widran in view of Hayashi do not disclose the carrier to have strips contacting webs in its longitudinal region, with which it is longitudinally moveable on the webs.

11. Karasawa teaches an analogous carrier in a resectoscope (col. 3, line 55), the carrier having strips 22d,e that contact surfaces (fig. 5) in its longitudinal region to enable a retreating operation, with which it is longitudinally movable on the surface in a horizontal direction (col. 6, line 50).

12. It would have been obvious to one of ordinary skill in the art at the time of the invention to have provided the resectoscope of Widran in view of Hayashi with the strips on the carrier taught by Karasawa in order to provide increased stability and optimizing the positioning of the internal elements of the Widran in view of Hayashi resectoscope by preventing the inclination of the insertion parts in the axial direction on the inside surface of the sheath.

***Response to Amendment***

13. The replacement drawing sheet which includes "prior art" added to fig.1, was received on November 5<sup>th</sup>, 2007 and has been entered.

***Specification***

14. Examiner acknowledges the description "Figure 1" provided in paragraph [0024] of the Substitute Specification filed on April 18, 2005. The objection with respect to this issue is herewith withdrawn.

15. Upon review of the Substitute Specification mentioned above, the specification still includes minor typos. In paragraph [0032] line 3, the term "is engages" should be -- it engages--.

16. In light of applicant's removal of the reference numerals from the claims, objections sited by the examiner in the first office action with reference to the drawings are withdrawn.

***Claim Objections***

17. In light of the applicant's correction of claim 2, the objection to claim 2 is herewith withdrawn.

***Response to Arguments***

18. Applicant's arguments with respect to claims 1-7 have been considered but are moot in view of the new ground(s) of rejection.

19. With regards to claim 10, applicant's arguments filed November 5<sup>th</sup>, 2007 have been fully considered but they are not persuasive.

20. The applicant's arguments with respect to claim 10 recite "Widran does not teach or suggest a support device for the optical system, wherein the support device is spaced from the proximal end of the tubular shaft as required". This argument is irrelevant to the recitations in

claim 10 since the claim recites "the optical system being supported with respect to the tubular shaft at a spacing from the proximal end of the tubular shaft". Widran does teach the optical system 28 being supported with respect to the tubular shaft 24 via 34 at *a spacing from the proximal end of the tubular shaft*. Although Widran discloses the elements 60 and 62 extend along the entire length of the endoscope sheath, the optical system 28 is still supported with respect to the tubular shaft 24 at a spacing in the diametrical direction within the shaft from a proximal end all the way toward the distal end of the shaft (see figure 2 of Widran). Therefore, the recitations of claim 10 read on Widran. Furthermore, applicant's statement of "wherein the support device is spaced from the proximal end of the tubular shaft" is drawn to the amended claim 1 that the applicant submitted. It has no relation to the recitations in independent claim 10.

21. With respect to applicant's argument drawn to the three point support system, a three point support system would have been obvious over Widran since one of ordinary skill in the art at the time of invention could have modified the length/size of the support device/ribs in order to allow a side of the optical system to engage/touch the inside surface of the tubular shaft since it has been held that, "[W]here the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation." *In re Aller*, 220 F.2d 454, 456, 105 USPQ 233, 235 (CCPA 1955) (MPEP 2144.05 II A).

Furthermore, it has been held that a change in the size of a prior art device is a design consideration within the skill of the art. *In re Rose*, 220 F.2d 459, 105 USPQ 237 (CCPA 1955).

22. Therefore, claim 10 stands rejected under 35 U.S.C. 103(a) as being unpatentable over Widran 3,900,022.

***Conclusion***

23. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alireza Nia whose telephone number is 571-270-3076. The examiner can normally be reached on Mo.-Fri.-7:30 AM-5:00 PM EST-Alternate Fridays Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda C. Dvorak can be reached on 571-272-4764. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair>-

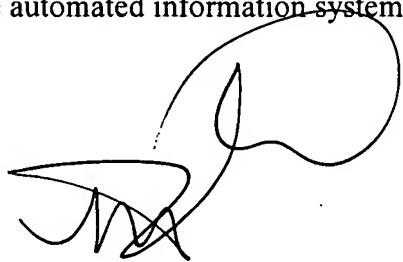
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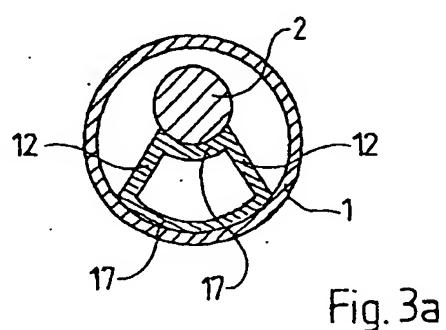
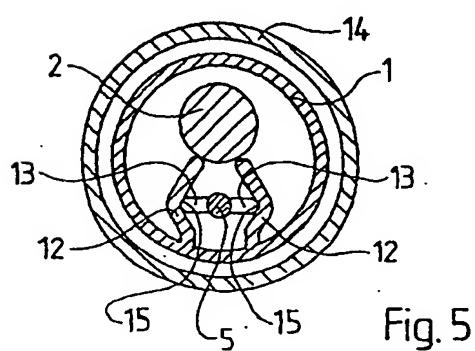
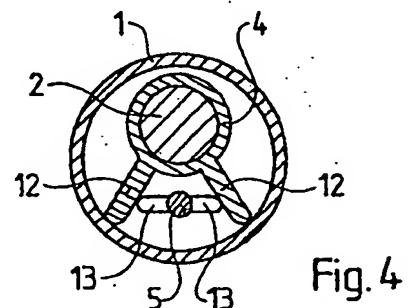
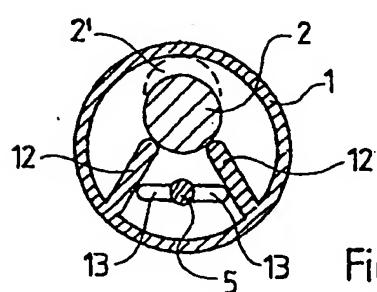
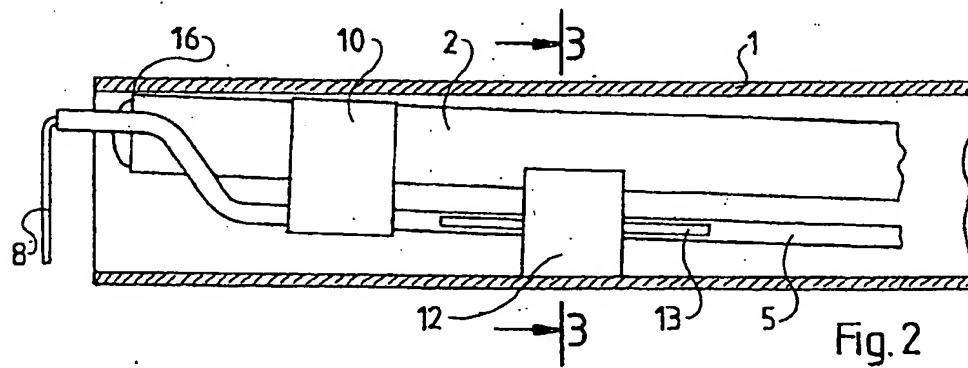
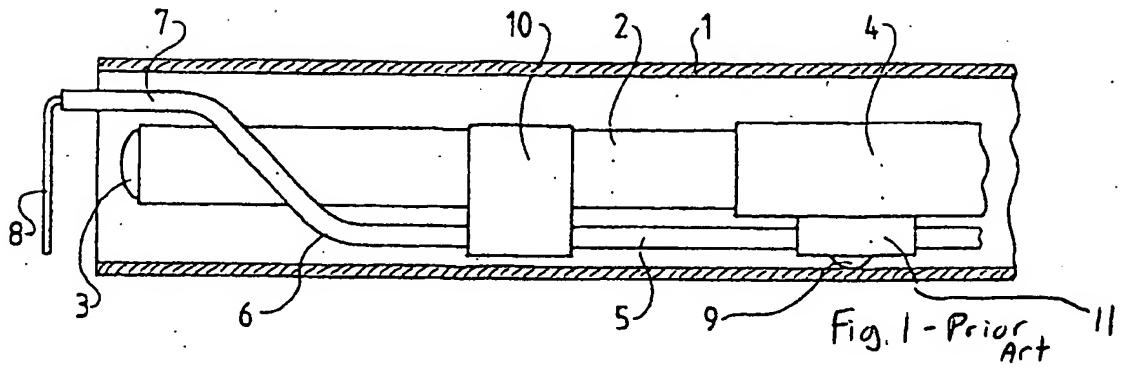
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Alireza Nia  
December 11<sup>th</sup>, 2007



LINDA C. M. DVORAK  
SUPERVISORY PATENT EXAMINER  
GROUP 3700

REPLACEMENT SHEET



Accepted by examiner. (John K. Antis)  
12/11/07